

### **REMARKS**

This responds to the Office Action mailed on November 7, 2007.

No claims are amended, canceled or added; as a result, claims 1-5 and 8-20 remain pending in this application.

#### **Double Patenting Rejection**

Claims 1-5 and 11-15 were provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-2, 26-27, 29-33 and 35 of copending U.S. Patent Application Serial No. 10/788,903 (Attorney Docket No. 1842.020US1).

Applicant does not admit that a case of obviousness-type double patenting exists with respect to claims 1-5 and 11-15. Further, in view of the continuing prosecution of this application and application 10/788,903, Applicant will consider filing a terminal disclaimer when all other issues related to the patentability of the claims have been resolved.

#### **§103 Rejection of the Claims**

Claims 1-5, 8-9 and 11-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto et al. (U.S. 6,916,247; hereinafter “Gatto”) in view of Hendrickson (U.S. Publication No. 2004/0087367) in view of Atwal et al. (U.S. Publication No. 2003/0061404; hereinafter “Atwal”) and further in view of Gottschalk (IBM Systems Journal, Vol. 42, No. 2). The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. See *Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion that a claim is obvious within § 103(a) depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966). The underlying factual issues set forth in *Graham* are as follows: (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught

or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; M.P.E.P. § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; M.P.E.P. § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l v. Teleflex Inc., et al.*, 127 S.Ct. 1727; 167 L.Ed 2d 705; 82 USPQ2d 1385 (2007) (citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

Applicant further notes that in determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Norton Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985); MPEP § 2141.02. (emphasis added). The Examiner must also recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 U.S.P.Q.2d (BNA) 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir. 1990).

Applicant respectfully traverses the rejection. In view of the differences between Applicant's claims at issue and the cited references, Applicant respectfully submits the claims are not obvious in view of Gatto, Hendrickson, Atwal and Gottschalk. In general, the independent claims recite systems and methods that provide a three party handshake for providing event management service on a wagering game network. The event management service first sends service information to a discovery agent, the discovery agent authorizes and authenticates the event management service and in response publishes the service information. A client such as a wagering game machine desiring to use the event management service obtains the service information from the discovery agent and uses the service information to contact the event management service. Applicant respectfully submits that when the claims are considered

as a whole, the cited references do not teach or suggest the present invention as claimed in the independent claims.

For example, at least one difference between cited references and the claims at issue may be found in independent claim 1, which recites in part “determining by the discovery agent if the event management service is authentic and authorized.” Independent claim 11 recites similar language regarding a discovery agent that determines if an event management service is authentic and authorized. The Office Action correctly states that Gatto does not disclose the recited language. However, the Office Action goes on to assert that Atwal discloses that a client is verified to be authorized to utilize the service (citing paragraph 52) and further that clients subject to authorization include server service providers (citing paragraph 43). Applicant respectfully disagrees with this interpretation of Atwal for several reasons. First, claims 1 and 11 recite that a discovery service provides authentication and authorization. Neither the cited section of Atwal nor Atwal in general discloses that a discovery service authenticates and authorizes a service. Second, Atwal discloses that a method call is authenticated as coming from a particular client. Atwal does not disclose that the client itself is authenticated before it is allowed to be on the wagering game network. Further, Atwal does not disclose that a service is authorized before it is allowed to be on a wagering game network. All of the activity in Atwal presumes that the client is already available on a network. As a result, Atwal does not disclose determining by a discovery agent if the event management service is authentic and authorized.

The Office Action further states that Gottschalk, at page 175 discloses that private UDDI registries may exist, where the registry is controlled to only permit allowed users may publish onto the registry. Gottschalk does not disclose any mechanism by which such control of the registry is maintained. Further, controlling what entries are placed in a registry does not imply authentication and authorization of a discovery service. For example, authorization may be accomplished through a user name/password entered by a user that places data into the registry. Thus Gottschalk does not disclose determining by a discovery agent if the event management service is authentic and authorized.

Further, Applicant has reviewed Hendrickson and can find no disclosure of determining by a discovery agent if the event management service is authentic and authorized.

For all of the reasons above, none of Gatto, Hendrickson, Atwal or Gottschalk, alone or in combination, discloses determining by a discovery agent if the event management service is authentic and authorized. Therefore there are differences between claims 1 and 11 and the cited references. As a result, claims 1 and 11 are not obvious in view of the combination of Gatto, Hendrickson, Atwal and Gottschalk. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 1 and 11.

Claims 2-5 and 8-9 depend from claim 1 and claims 12-15 and 18-19 depend from claim 11. These dependent claims inherit the elements of their respective base claims 1 and 11 and are not obvious in view of the combination of Gatto, Hendrickson, Atwal and Gottschalk for at least the reasons discussed above regarding their respective base claims.

Even if the combination of Gatto, Hendrickson, Atwal and Gottschalk disclosed the elements of Applicant's claims (which is not admitted), "[a] factfinder should be aware. . . of the distortion caused by hindsight bias and must be cautious of argument reliant upon *ex post* reasoning." *KSR Int'l Co.* at 1397. *See also Graham* at 474. The Examiner cannot use the Appellant's structure as a "template" and simply select elements from the references to reconstruct the claimed invention. *In re Gorman*, 933 F.2d 982, 987, 18 U.S.P.Q.2d (BNA) 1885, 1888 (Fed. Cir. 1991).

The Office Action uses four references in the rejection of claims 1-5, 8-9 and 11-19. This is highly suggestive that the Examiner is using Applicant's structure as a template and selecting individual elements from each reference in a hindsight reconstruction of Applicant's claimed invention. Further, the use of individual elements from four references suggests that the Examiner is merely considering whether the differences are obvious, not the invention as a whole.

Claims 10 and 20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Gatto in view of Hendrickson in view of Atwal and in view of Gottschalk as applied to claims 1 and 11 above, and further in view of Atkinson et al. (U.S. Publication No. 2004/0142744; hereinafter "Atkinson").

Claim 10 depends from claim 1 and claim 20 depends from claim 11. These dependent claims therefore inherit all of the elements of their respective base claims, including elements directed to verifying by the discovery agent that the event management service is authentic and

authorized for the gaming network. As discussed above, none of Gatto, Hendrickson, Atwal or Gottschalk disclose these elements. Additionally, Applicant has reviewed Atkinson and can find no disclosure of verifying by the discovery agent that the event management service is authentic and authorized for the gaming network. As a result, the combination of Gatto, Hendrickson, Atwal, Gottschalk and Atkinson fails disclose each and every element of Applicant's claims 10 and 20, including inherited elements. Thus there are differences between claims 10 and 20 and the cited references. Therefore claims 10 and 20 are not obvious in view of Gatto, Hendrickson, Atwal, Gottschalk and Atkinson. Applicant respectfully requests reconsideration and the withdrawal of the rejection of claims 10 and 20.

Additionally, the Office Action uses five references in the rejection of claims 10 and 20. This is highly suggestive that the Examiner is using Applicant's structure as a template and selecting individual elements from each reference in a hindsight reconstruction of Applicant's claimed invention. Further, the use of individual elements from five references suggests that the Examiner is merely considering whether the differences are obvious, not the invention as a whole.

#### Reservation of Rights

In the interest of clarity and brevity, Applicant may not have equally addressed every assertion made in the Office Action, however, this does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner's personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to

pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

### CONCLUSION

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at (612) 373-6954 to facilitate prosecution of this application.

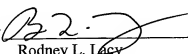
If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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Date May 7, 2008

By

  
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**CERTIFICATE UNDER 37 CFR 1.8:** The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 7 day of May 2008.

Zhakaalazky M. Carrion

Name

  
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